



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,347	08/28/2001	Manu Ghela	GHEL-0312	9180

7590 03/25/2004

Kenneth C. Booth
Schmeiser, Olsen & Watts LLP
18 East University Drive, #101
Mesa, AZ 85201

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
----------	--------------

3713

12

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,347

Applicant(s)

GHELA, MANU

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,11-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,5,6,11,13,16-18,20 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 12,14,19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of claims 12, 14, 19, 21-24 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the Applicant believes that the Examiner has to examine the patentability of all species by examining species III. This is not found persuasive because each claim is evaluated on its own merits, not in piecemeal fashion. Species III is a specific combination of elements and the patentability of the individual elements is not considered in examining the claim; the patentability of the combination is considered. Having fewer limitations and broader scope does not make the species a genus. Further, arguments about search burden are not commensurate to the scope of the restriction. The restriction requires that upon traversal, the applicant to submit evidence or identify such evidence now of record to show the species are obvious variants.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 2, 5, 6, 11, 13, 16-18, 20 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Allowable Subject Matter

Claims 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14, 19 and 21-24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3713

The following is an examiner's statement of reasons for allowance:

As per the specification and the interview with the Applicant, the Examiner interprets the following essential claim limitations to be defined as follows:

payout insured- Lottery ticket that is insured for full payment of winnings no matter the winning size

tax insured- Lottery ticket that is insured for the winning amount plus an additional amount equal to at least a portion of the taxes

non-payout insured- Lottery ticket that is not payout insured. Winner will receive amount less than full winnings or be subject to annuities

non-tax insured- Lottery ticket that is not tax insured. Winner will receive amount less than needed to pay off any taxes on winnings.

tax and payout insured- Ticket that is insured both for payout and taxes on winnings. Winner will receive full amount of winnings no matter what size and additionally an amount to cover at least a portion of the taxes.

The claims are allowable based on the interpretation of their language as explicitly defined above. The prior art of record does not disclose the combination of both payout and tax insurance options on a lottery ticket, nor is such a feature obviated.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

This application is in condition for allowance except for the following formal matters:

Claims 14, 19, and 21- 24 are objected to for minor informalities under 37 C.F.R §1.175.

The claims are unclear via parent claims 13 and 16, as it is stated that the award amount is different for tickets that are non-insured. It is not clear what type of insurance is meant. By context, the Examiner best understands it to mean that which has been previously discussed in the claim. However, the claim language needs to be amended to clarify and make clear the exact process.

To clarify, the Applicant needs to insert a description of the type of insurance to which the claim is referring. As presently claimed, the word "non" is used to describe the absence of insurance. There is no identifier to clarify the type of insurance to which the "non" refers. The ticket should be defined as either non-payout insured or non-tax insured. The usage of non-insured is unclear as both types of insurance are present and it is unclear to which insurance type the phrase is referring.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Art Unit: 3713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
March 19, 2004

A handwritten signature in black ink, appearing to read 'M O'Neill', with a stylized flourish at the end.

**MICHAEL O'NEILL
PRIMARY EXAMINER**